

This Opinion is not a
Precedent of the TTAB

Mailed: February 8, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Jerry Wagreich
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Serial No. 87356161
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Holly H. Saporito of Alston & Bird for Jerry Wagreich.

Benjamin Rosen, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.
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Before Taylor, Shaw and Lebow,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Jerry Wagreich (“Applicant”) seeks registration on the Principal Register of the

mark  for services identified as:

Electronic commerce payment services, namely, establishing funded accounts used to purchase goods and services on the Internet; Pre-paid purchase card services, namely, processing electronic payments made through prepaid cards; Pre-paid purchase card services, namely, processing electronic payments through pre-paid cards; Processing electronic payments made through prepaid cards; Providing electronic processing of electronic funds transfer, ACH, credit card, debit card, electronic check and electronic payments; Providing electronic processing of

ACH and credit card transactions and electronic payments via a global computer network; Providing electronic processing of credit card transactions and electronic payments via a global computer network; Providing multiple payment options by means of customer-operated electronic terminals available on-site in retail stores; Stored value prepaid card services, namely, processing electronic payments made through prepaid cards, in International Class 36.¹

The description of the mark reads: “The mark consists of the literal element ‘IPAYED’ in white letters on a blue background, with a blue and green dot forming a globe above the letter ‘I.’” The colors white, blue, and green are claimed as a feature of the mark.

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as used in connection with the identified services, so resembles the commonly-owned standard-character marks, PAYD for “Electronic funds transfer; credit, debit, stored value, prepaid, loyalty and gift transaction processing services and related transaction information processing services,” in International Class 36,² and PAYD PRO for “Electronic funds transfer; Credit, debit, and prepaid transaction processing services and related transaction information processing services,” in International Class 36,³ as to be likely to cause confusion or mistake or to deceive.

¹ Application Serial No. 87356161, filed on March 2, 2017 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to use the mark in commerce.

² Registration No. 4923050, issued March 22, 2016.

³ Registration No. 5144231, issued February 21, 2017.

When the refusal was made final, Applicant appealed and requested reconsideration, which was denied. The appeal resumed and Applicant filed his brief. The Examining Attorney then requested remand for the submission of additional evidence, which was granted. Following the remand, the appeal again resumed and Applicant was offered the opportunity to file a Supplemental brief, but did not do so. The Examining Attorney then filed his brief.

I. Evidentiary Issue

To support his argument that Registrant's PAY-formative marks are weak and entitled to a narrow scope of protection, Applicant submitted copies of thirty-three third-party registrations for marks including the term PAY.⁴ In his brief, Applicant specifically argues that Registrant's marks are "only entitled to a 'restricted scope of protection'"⁵ because they were allowed to register despite the fact that "there were more than 500 federal registrations for PAY-formative marks in Class 36 [when the PAYD mark registered]"⁶ and "at least 600 PAY-formative marks in Class 36 [when the PAYD PRO mark registered]."⁷

The Examining Attorney objects to Applicant's arguments relying on the "500" or "600" registrations on the ground that only thirty-three registrations were actually made of record. According to the Examining Attorney,

While the Board may consider the 33 registrations that are properly of record, the trademark examining attorney

⁴ Applicant's December 10, 2020 Response to Office Action, TSDR pp. 27-56, 59-64.

⁵ Applicant's Br., p. 10, 6 TTABVUE 15.

⁶ *Id.*

⁷ *Id.*

objects to any consideration of any evidence that is not specifically made part of the record or and objects to considering the unsupported allegations relating to said “500” or “600” registrations and respectfully requests that the Board disregard these allegations.⁸

“Attorney argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018). Applicant has not introduced the 500 or 600 PAY-formative marks that may have been registered at the time that Registrant’s marks issued to support his assertion that Registrant’s marks are weak and entitled to a narrow scope of protection. Accordingly, in assessing Applicant’s argument, we consider only those registrations that were made of record.

II. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”).

⁸ Examining Attorney’s Br., 14 TTABVUE 5.

A. *The nature and similarity or dissimilarity of the services, the established, likely-to-continue trade channels, and the classes of purchasers.*

Under the second *DuPont* factor, we compare the services as they are identified in the application and the cited registration. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

Under this *DuPont* factor, the Trademark Examining Attorney need not prove, and we need not find, similarity as to each and every activity listed in the description of services. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any activity encompassed by the identification of services in a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Applicant's services include "Processing electronic payments made through prepaid cards;" "Providing electronic processing of electronic funds transfer . . .;" and "Providing electronic processing of credit card transactions and electronic payments via a global computer network." Registrant's services include "Electronic funds transfer; credit, debit, and prepaid transaction processing services." Applicant's and Registrant's services are in part legally identical inasmuch as both identify electronic funds transfer and the processing of prepaid and credit card transactions.

Applicant argues that the Examining Attorney has failed to submit any evidence to support the conclusion that the services are legally identical.⁹ This argument is unpersuasive for two reasons. First, the services are facially identical and additional evidence is not needed. As noted above, both Applicant's and Registrant's services identify electronic funds transfer and processing of prepaid and credit card transactions in their respective recitations. *See Hewlett-Packard*, 62 USPQ2d at 1005 ("While additional evidence, such as whether a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis, the Board [erred by] not consider[ing] the important evidence already before it, namely the ITU application and . . . registrations.").

Second, Applicant's argument that the Examining Attorney failed to submit any evidence is simply incorrect. The Examining Attorney introduced web page excerpts from eight third-party financial companies such as Paypal, Venmo, PaySimple, and Square, among others, showing that such companies provide both Applicant's and Registrant's services under the same mark.¹⁰

Applicant also argues that his services and Registrant's services are unrelated because they serve different customers and use different technologies:

Applicant's services relate to digital banking and focus on providing personal bank accounts to consumers, specifically, "unbanked" consumers for whom traditional bank accounts are unavailable. Applicant's payment rail is

⁹ Applicant's Br., p. 11, 6 TTABVUE 16.

¹⁰ *See* June 21, 2021 Office Action, TSDR pp. 3-66. Although Applicant's argument was made before the Examining Attorney requested a remand for the purpose of introducing the evidence, Applicant did not file a supplemental brief to address the evidence. 12-13 TTABVUE.

patent-protected and different and distinct from the existing credit and debit card payment systems. Conversely, Registrant, as demonstrated by the Cited Marks' specimens, offers a smartphone application, or "app," which allows merchants to accept mobile credit and debit card payments by turning their mobile devices into mobile point-of-sale solutions.¹¹

This argument is unavailing. Applicant cannot narrow the scope of the respective services by extrinsic evidence allegedly showing Applicant's and Registrant's actual use of the marks. "Likelihood of confusion must be determined based on an analysis of the mark as applied to the . . . services recited in applicant's application vis-a-vis the . . . services recited in [a] . . . registration, rather than what the evidence shows the . . . services to be." *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (citing *Canadian Imperial Bank v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987)).

Furthermore, as to the third *DuPont* factor, because the respective services are in part legally identical without restriction, we must presume that these legally-identical services are offered in the same trade channels and to the same classes of purchasers. *Cai*, 127 USPQ2d at 1801 ("With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and 'presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods. . . .") (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there

¹¹ Applicant's Br., p., 13, 6 TTABVUE 18.

are legally identical goods, the channels of trade and classes of purchasers are considered to be the same). Thus, we consider Applicant's and Registrant's trade channels and classes of purchasers to overlap.

The *DuPont* factors regarding the similarity of the services, channels of trade, and classes of purchasers favor a finding of a likelihood of confusion.

B. The strength of the cited marks.

Before reaching the degree of similarity of the marks, we address Applicant's arguments regarding the strength of the cited marks. "A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace [or commercial] strength (secondary meaning)." *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). For likelihood of confusion purposes, "the strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak." *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003).

Applicant's weakness argument is supported only with third-party registration evidence, which goes solely to the marks' conceptual strength. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017) ("[T]hird-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services.") (citing *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976)); see also *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *3 (TTAB 2020) ("[E]vidence of third-party registrations is relevant to 'show the sense in which . . . a mark is used in ordinary parlance.'" (citation omitted). The Federal Circuit has held

that if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, that may indicate that the common element has some non-source identifying significance that undermines its conceptual strength as an indicator of a single source. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance’ . . . that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak’”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

To support his argument that the cited marks are weak and entitled to only a narrow scope of protection, Applicant introduced copies of thirty-three registrations for PAY-formative marks used in connection with a variety of services in International Class 36.¹² Some of the registrations lack probity because they identify services unrelated to Registrant’s services.¹³ Of the remaining registrations, the following are representative:

¹² Applicant’s December 10, 2020 Response to Office Action, TSDR pp. 15-59. All the marks listed are in typed or standard character form.

¹³ For example, Reg. No 4461502, for the mark PAI, identifies health insurance claims administration; Reg. No 4863290, for the mark PayAID, identifies debt recovery and collection services; Reg. No. 4769209, for the mark PayNav, identifies providing financial and insurance information, and Reg. No. 4182262, for the mark Payday IRA, identifies individual retirement account services. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (third-party registrations may be of limited probative value where the goods identified in the registrations appear to be in fields which are far removed from the goods at issue); *Sheller-Globe Corp. v. Scott Paper Co.*, 204 USPQ 329, 336 (TTAB 1979) (“[W]e need not comment on

Reg. No.	Mark	Relevant Services in Class 36
4558264	@PAY	Electronic payment processing services that facilitate making electronic purchases by electronic mail or a web based electronic network; financial transaction services for others, namely, clearing and reconciling financial transactions, and providing secure commercial transactions and payment options by electronic mail or a web based electronic network
1632567	PAY\$TREAM	Banking services; namely, electronic funds transfer services
4272003	PAYEDGE	Financial transaction services, namely, providing secure commercial transactions and payment options using a mobile device at a point of sale
3731696 and 2658509	PAYFLOW and PAYFLOW PRO	Financial services, namely, providing financial transaction processing services and financial information by electronic means via computer networks and global information networks . . . in the field of electronic fund transfer and payment processing services
2470588	PAYMAP	Financial services, namely electronic payment services, namely electronic processing and transmission of bill payment data, automated bill payment services, electronic funds transfer services
3013066	PAYMODE	Internet banking services, namely, providing electronic payment and remittance processing services to business customers
4467590	PAYNET	Person-to-person electronic payment services; electronic and digital payment services
2841418	PAYPASS	Financial services, namely banking services and credit card services; providing credit card and debit card services; advice relating to all the aforesaid services
1435915	PAYPOINT	Electronic payment for goods and services and/or withdrawal of cash by an automated teller card
4410570	PAYSCOUT	Providing electronic processing of electronic funds transfer, ACH, credit card, debit card, electronic check and electronic payments
3363741	PAYSIGN	Financial services, namely, providing electronic funds transfer, money transfer and bill payment services utilizing electronic encryption, authentication and authorization

the third-party registrations placed in the record by applicant save to note that they pertain to completely unrelated goods and are therefore irrelevant.”).

Based on the number of registered PAY-formative marks, Applicant contends that “the Cited Marks are only entitled to a ‘restricted scope of protection,’ and, as such, should only bar the registration of marks ‘as to which the resemblance . . . is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two.’”¹⁴ Applicant argues further that “the Cited Marks’ use of PAY-derivative marks is suggestive of their proffered services.”¹⁵ Thus, according to Applicant, “consumers are able to distinguish among different sources when they encounter “PAY” or “PAID” in the financial services marketplace.”¹⁶

In response, the Examining Attorney argues that “[a] review of the registrations that are provided in the record may demonstrate that the term ‘PAY’ plus additional matter is used by multiple registrants, but notably absent from all the registrations is a single registrant using the term ‘PAYD’, ‘PAYED’, or even its phonetic equivalent ‘PAID’.”¹⁷ Thus, according to the Examining Attorney, “[s]ince applicant has not provided any marks using the term ‘PAYD’, ‘PAYED’ or ‘PAID’, the third party marks in the evidence are not similar to the marks at issue.”¹⁸

We find that the third-party registration evidence establishes that PAY-formative marks are conceptually weak when used in connection with financial services such as those offered by Applicant and Registrant. The term is shared by a number of

¹⁴ Applicant’s Br., p. 10, 6 TTABVUE 15, citing *Anthony’s Pizza & Pasta Int’l Inc. v. Anthony’s Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009).

¹⁵ Applicant’s Br., p. 10, 6 TTABVUE 15.

¹⁶ *Id.* at 11, 6 TTABVUE 16.

¹⁷ Examining Attorney’s Br., 14 TTABVUE 13.

¹⁸ *Id.* at 14 TTABVUE 14.

marks that combine it with other wording or characters. Nevertheless, we agree with the Examining Attorney that none of the third-party registrations show use of the terms, PAYED, PAYD or PAID, either alone or with other matter, in connection with the services at issue. Thus, the scope of protection to which the cited marks are entitled is not as narrow as Applicant suggests. *See In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745-46 (TTAB 2018) (discounting probative value of third-party registrations “for non-identical terms” to establish that the cited registered mark was weak).

Despite the weakness of PAY-formative marks when used in connection with payment services, we also must recognize that it has “often been emphasized that even weak marks are entitled to protection against confusion.” *Hunt Control Sys. Inc. v. Koninklijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1567-68 (TTAB 2011) (quoting *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974)).

Due to the conceptual weakness of the term PAY, Registrant's marks are entitled a slightly reduced scope of protection.

C. The similarity or dissimilarity of the marks in their entireties in terms of appearance, sound, connotation and commercial impression.

Next, we consider the *DuPont* factor relating to the similarity of the marks. In comparing the marks we must consider their appearance, sound, connotation and commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Similarity as to any one of these factors may be sufficient to support a finding that the marks

are confusingly similar. *See Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”); *Inn at St. John’s*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) (“In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone ‘may be sufficient to support a holding that the marks are confusingly similar.’”).

The emphasis of our analysis must be on the recollection of the average consumer, who normally retains a general, rather than specific, impression of trademarks. We remain mindful that “marks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014). Because the respective services are financial services such as electronic funds transfer and financial transaction processing services, the average consumer is an ordinary consumer of electronic financial services such as banking, credit card, debit card, and pre-paid card services.

Moreover, the identity of the services reduces the degree of similarity between the marks that is necessary for confusion to be likely. *See, e.g., Viterra*, 101 USPQ2d at 1912.

The Examining Attorney argues that the marks are similar because “PAYD” and “PAYED” are highly similar dominant elements, “with an identical pronunciation, a highly similar appearance only differing by one letter, and a highly similar

connotation.”¹⁹ Further, “[t]he addition or absence of the letter ‘E’ has very literal [sic] impact on the appearance, sound, and connotation of these terms, and applicant provides no evidence to the contrary.”²⁰ As a result, according to the Examining Attorney, “the average purchaser will generally associate each mark with the word ‘PAID’, creatively misspelled with a letter ‘Y’.”²¹

As for the other matter in Applicant’s mark, the Examining Attorney argues that the “additional wording and design elements . . . do not sufficiently distinguish the marks in order to obviate confusion.”²² Specifically, “[t]he prefix ‘I’ is a descriptive signifier of a service that is performed over the internet, such as applicant’s services would be.”²³ And “the word portion of the applied-for mark is more dominant than its design features because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the applicant’s services.”²⁴

For his part, Applicant argues that the Examining Attorney ignored the “Dominant Syllable ‘T’ in Applicant’s Mark”:²⁵

[T]he Examining Attorney impermissibly ignores one of the primary elements of Applicant’s Mark, *i.e.*, one of the only two syllables of Applicant’s Mark. Applicant’s Mark is not simply “PAYED”: it is “IPAYED” & Design, with a stress

¹⁹ Examining Attorney’s Br., 14 TTABVUE 10.

²⁰ *Id.* at 14 TTABVUE 11.

²¹ *Id.* at 14 TTABVUE 10-11.

²² *Id.* at 14 TTABVUE 11.

²³ *Id.*

²⁴ *Id.* at 14 TTABVUE 12.

²⁵ Applicant’s Br., p. 5, 6 TTABVUE 10.

on the “I” of “IPAYED.” Consumers are accustomed to “i-” formative marks and would place stress on that first syllable.²⁶

For support, Applicant relies on, inter alia, *Jean Leon, S.L. v. La Scala Rests., Corp.*, 2020 TTAB LEXIS 314, at *35 (TTAB 2020) for the premise that “the lead element of a mark is most likely to be impressed upon the mind of a purchaser and remembered.”²⁷ Applicant also argues that “Examining Attorney ignores that Applicant’s Mark and the Cited Marks use different spellings. Applicant’s Mark uses the spelling ‘PAYED,’ while the Cited Marks omit the ‘e.’”²⁸ According to Applicant, “Taken together, the additional syllable ‘I’ and the distinctive spelling of ‘PAYED’ show that Applicant’s Mark and the Cited Marks are sufficiently dissimilar such that consumer confusion is not likely among these marks.”²⁹ Lastly, regarding the design elements of Applicant’s mark, Applicant argues that “[t]he design, font, and color elements leave a distinct impression on consumers.”³⁰

Although marks must be considered in their entirety, it is settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *Viterra*, 101 USPQ2d at 1908; *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“There is nothing improper in stating that,

²⁶ *Id.*

²⁷ *Id.*

²⁸ *Id.* at 6, 6 TTABVUE 11.

²⁹ *Id.* at 7, 6 TTABVUE 12.

³⁰ *Id.* at 7-8, 6 TTABVUE 12-13.

for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”).

We find that the dominant element of all three marks is the incongruity created by the coined spelling of PAYD and PAYED. Both suggest the connotation of something “paid” and they likely are pronounced the same, but they are spelled—or misspelled—in an unusual way.

The addition of the prefix “T” before the term PAYED in Applicant’s mark does little to distinguish it from Registrant’s marks. “T” is generally understood to refer something Internet-based when used in connection with online services such as Applicant’s, which include processing of financial transactions and payments “via a global computer network.” See *In re Zanova, Inc.*, 59 USPQ2d 1300, 1304 (TTAB 2000) (“When we consider the possible significance of ‘T’ in ITOOL to prospective purchasers of applicant’s goods or services, we find that they will readily accept ‘T’ as meaning ‘Internet’[.]”). The “T” in Applicant’s mark also could be viewed by the consumer as a phrase, “I paid.”

Although Applicant is correct that the first portion of a mark is often its most important and dominant feature, the prefix “T” is unlikely to be viewed as the dominant feature of Applicant mark. “T” is ubiquitous when used in connection with online services, and, if viewed as part of the phrase “I paid,” merely modifies and is subordinate to the term PAYED. Accordingly, we disagree that the letter “T” is sufficiently distinguishing in this case.

Regarding the presence of the term PRO in Registration No. 5144231, we find this term does little to distinguish Applicant's iPaid mark from Registrant's PAYD PRO mark. The term PRO in Registrant's mark simply modifies PAYD and suggests that the services offered by Registrant under this mark are directed toward consumers with more advanced or "professional" financial needs.³¹ Indeed, two of the third-party registrations submitted by Applicant are commonly owned and are for the marks PAYFLOW and PAYFLOW PRO, both for identical financial services.³²

When we consider the marks as a whole, we find them to be more similar than dissimilar. That is, , PAYD, and PAYD PRO are similar in connotation and commercial impression because they all share the incongruity created by sounding like "paid" but spelled as PAYED or PAYD. Similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar. *See Thor Tech*, 90 USPQ2d at 1635; *White Swan*, 8 USPQ2d at 1535.

The design elements of Applicant's mark are less significant in distinguishing the marks because when a mark comprises both words and a design, the words are normally accorded greater weight. *See Viterra*, 101 USPQ2d at 1911. Here, Applicant's globe design is very small compared to the rest of the mark, and the blue rectangular background or "carrier" has little source indicating ability. *See In re*

³¹ *See* <https://www.merriam-webster.com/dictionary/pro>. "The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions.

³² *See* Reg. Nos. 2658509 and 3731696, Applicant's December 10, 2020 Response to Office Action, TSDR pp. 35-36.

Anton/Bauer, Inc., 7 USPQ2d 1380, 1381 (TTAB 1988) (holding parallelogram designs used as background for word marks not inherently distinctive). *Compare In*

re Covalinski, 113 USPQ2d 1166 (TTAB 2014) ( not confusingly similar to RACEGIRL in standard characters); *Parfums de Couer Ltd. v. Lazarus*, 83



USPQ2d 1012 (TTAB 2007) (**BODYMAN** for a television series not confusingly similar to BOD MAN and BOD for fragrances). We find that Applicant's design elements do not dominate the commercial impression of Applicant's mark.

Moreover, an applicant cannot, by presenting its mark in special form, avoid likelihood of confusion with a mark that is registered in standard characters because the registered mark presumably could be used in a similar manner of display. *See Viterra*, 101 USPQ2d at 1910; *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1353, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). We must consider Registrant's standard character marks regardless of font style, size, or color, *Id.*, including iterations displaying the mark in the same font and colors as the word IPAYED in Applicant's mark.

In finding that the marks are more similar than dissimilar in their entireties, we acknowledge that Applicant's marks are entitled to a slightly narrower scope of protection. But, as noted, none of the third-party marks introduced by Applicant have the same incongruity created by the spelling PAYD or PAYED and, therefore, none of them are as close to Registrant's marks as is Applicant's mark. Here, the shared

use of PAYED or PAYD creates a similar overall connotation or commercial impression between the marks in their entireties.

In sum, although the marks have somewhat different appearances and slight differences in sound, this does not mandate a finding that there is no likelihood of confusion, given the similarity in connotation and commercial impression between the dominant element of Applicant's and Registrant's marks. *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511 (2009); *In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581 (TTAB 2007). Here, the similarities in connotation and commercial impression outweigh the differences in appearance and overall slight differences in sound.

This *DuPont* factor favors a finding of a likelihood of confusion.

D. Applicant's prior registration and the thirteenth DuPont factor

Applicant owned a prior registration, now canceled, for a similar mark,



, for in part identical services.³³ The registration was canceled for failure to file a Section 8 affidavit of continued use. 15 U.S.C. § 1058.

Applicant argues that because his prior registered mark was not cited against Registrant's later-filed PAYD mark, the applied-for mark "should be approved for registration today."³⁴ In other words, Applicant is arguing that because his prior

³³ Reg. No. 3395015, issued on March 11, 2008, canceled October 17, 2014. In the prior mark the letter "P" is in lower case, whereas in the applied-for mark it is in upper case.

³⁴ Applicant's Br., p. 8, 6 TTABVUE 13.

mark wasn't cited against Registrant's PAYD mark in the past, Registrant's marks shouldn't be cited against his applied-for mark now.

We consider Applicant's prior registration argument under the thirteenth *DuPont* factor, which relates to "any other established fact probative of the effect of use." *DuPont*, 177 USPQ at 567. "Where an applicant owns a prior registration that is over five years old and the mark is substantially the same as in the applied-for application, this can weigh against finding that there is a likelihood of confusion." *Inn at St. John's*, 126 USPQ2d at 1746 (citing *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012)).

In *Strategic Partners*, the Board addressed the "unique situation" of coexistence of an applicant's existing registration with a cited registration for over five years. In that case, the applicant's applied-for mark, ANYWEAR, was substantially similar to its existing registered mark, ANYWEARS, and identical goods were offered under both marks. The Board, noting that the ANYWEARS mark, registered later in time, had coexisted with the cited registration, ANYWEAR BY JOSIE NATORI (stylized composite design mark), for "jackets, shirts, pants, stretch T-tops and stoles," ultimately held:

Applicant's registered mark, a mark that is substantially similar to the applied-for mark, both covering "footwear," has coexisted with the cited mark for over five years. At this stage, applicant's existing registration is over five years old, and thus is not subject to attack by the owner of the cited registration on a claim of priority and likelihood of confusion. *Cf. In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994). We find that these facts tip the scale in favor of applicant and a finding of no likelihood of confusion.

Id. at 1399.

There are several problems with Applicant's argument. Applicant's canceled registration is not entitled to any of the presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *See Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973) ("Whatever benefits a registration conferred upon appellee were lost by him when he negligently allowed his registration to become canceled."); *In re Hunter Publ'g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation "destroys the Section [7(b)] presumptions and makes the question of registrability 'a new ball game' which must be predicated on current thought."). Unlike the situation in *Strategic Partners*, Applicant's earlier, now-cancelled registration is not an "existing registered mark." *Strategic Partners*, 102 USPQ2d at 1400. Thus, *Inn at St. John's* and *Strategic Partners* do not apply.

The circumstances surrounding Applicant's prior registration are more similar to those found in *In re Allegiance Staffing*, 115 USPQ2d 1319, 1325 (TTAB 2015). In *Allegiance Staffing*, applicant's mark had inadvertently expired, and within two weeks of expiration, applicant reapplied for registration for the identical mark and identical services. During the period of eleven years when applicant's registration had been in effect, six third-party registrations issued, and two additional applications were approved for registration. The Board took into consideration in the likelihood of confusion analysis that several examining attorneys found the "now-cited registrations were not likely to cause confusion" with applicant's prior registered mark during its existence, and that applicant promptly refiled the

application for the identical mark and identical services once the registration lapsed. *Id.*, 115 USPQ2d at 1324.

We find that Applicant's situation does not justify the outcome afforded in *Allegiance Staffing*. Applicant's prior registration was canceled before the issuance of either of the cited registrations. Thus, unlike *Allegiance Staffing*—where numerous marks coexisted for years—Applicant's and Registrant's marks never coexisted on the register. In addition, Applicant waited more than two years after cancellation of the prior registration before filing the present application.

We decline to be bound by the action of one examining attorney taken nearly ten years ago on a different record. To hold otherwise would give preclusive effect to the decision of the examining attorney, and the Board is not bound by the decisions of examining attorneys. To the contrary, "the [US]PTO must decide each application on its own merits, and decisions regarding other registrations do not bind either the [USPTO] or [the reviewing] court." *In re Boulevard Entm't*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003). The failure to cite Applicant's prior registration against Registrant's PAYD mark does not compel the issuance of a registration to Applicant if it would otherwise be improper to do so. *Cf. In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009). The thirteenth *DuPont* factor is neutral.

E. Conclusion

Having considered all the evidence and arguments on the relevant *DuPont* factors, we conclude that there is a likelihood of confusion between Applicant's mark and Registrant's marks, for in-part identical services.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.